

Remarks

Claims 1-41 are pending. Claims 1-41 are rejected.

Claims 1-20, 22-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2002/0095368 (Tran) in view of U.S. Pub. No. 2006/0010377 (Anecki) and in further view of U.S. Pub. No. 2001/0049707 (Tran707). Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tran in view of Anecki and in further view of U.S. Pub. No. 2006/0190443 (Mathews).

Applicants' Attorney maintains, for the reasons stated in the previous reply, that the earliest effective filing date of Tran appears to be May 1, 2000, after the filing date of the instant application. Tran does not properly state whether the application is a "continuation, divisional or continuation-in-part" of Application Ser. No. 09/792,828. The Examiner indicates that "in the front page of TRAN's publication No.: US 2002/0095368 A1 printed that this is a provisional application No. 60/185,644, filed on Feb. 29, 2000, which is before the filing data of the instant application." Office Action, January 10, 2008, p. 2. This, however, does not appear to remedy Tran's apparent defective priority claim. See, MPEP 201.11 III and Section 3: Benefit Claims To Prior Applications under 35 U.S.C. §§ 119(e), 120, 121, and 365(c) prepared by the Office of Patent Legal Administration (OPLA).

With regard to claim 1, Anecki does not disclose allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information. The Examiner relies on the following passages of Anecki to find the above limitation:

Individuals responsible for the generation, approval, and tracking of legal documents, such as the administrator, directors, and legal counsel, use the extended services of the legal document server to control the legal document creation and approval process. For example, directors establish the business

rules by which and for whom a legal document can be produced; the directors also review the legal document request for technical accuracy and actual availability for each subject matter product in their domain; and the legal counsel approves the legal content of the legal document. The legal document server also provides services to track legal documents once the legal documents are issued to the customer.

The legal document server provides services to customers and marketing representatives to track the approval status of a legal document awaiting approval from directors. Customers use the previously described Recipient client to access the legal document server to determine the approval status of a legal document.

Anecki, [0046]-[0047].

In one embodiment of the present invention, the legal document is retained in the legal document database for status reporting and possible amendment. For example, a customer reviewing a computer chip and its specifications under a NDA may desire to obtain other computer chips. In this case, a new NDA is not generated. An amendment to the original NDA is generated and sent the customer for execution. The need for an amendment is detected when there is a change in status 1180 of the legal document. In which case, an amendment is generated 1190, the legal document database is updated, and the requestor is notified by a confirmation 1192 of the availability of the amendment.

In one embodiment of the present invention, the status of a legal document awaiting approval may be checked by the requester through the services of the legal document server. An address identifying the location of an approval status document is sent to the requester in an initial confirmation message 1120. The requestor uses the address of the approval status document to retrieve a approval status document that is updated by the legal document server as the legal document moves through the approval process.

Anecki, [0052]-[0053].

The above passages, however, simply do not discuss invention disclosures or inventors.

With regard to claim 1, Anecki does not disclose allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitation.

With regard to claim 3, Anecki does not disclose prompting the user for classification information classifying the invention disclosure into a technology area. As discussed above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitation. The Examiner, however, relies on the "Filter" button of Figure 21 and the following passages of Anecki to find the above limitation:

FIG. 21 is a search entry form of a legal document status reporting embodiment of the present invention. The form includes a customer name entry field 2900 for entry of a recipient name used to search the legal document database. A legal document administrator searches of legal documents issued to recipient by entering a recipient name in the customer name entry field and selecting the "Filter" button 2902.

FIG. 22 is a search entry form and a filtered result list of a legal document status reporting embodiment of the present invention. This form can be the same form as the form illustrated in FIG. 21 after entering a recipient name in the customer name entry field 2900 and selecting the "Filter" button 2902. The form includes a recipient list portion 3000 including an identifier 3002 for a legal document recipient. Selecting the identifier brings up a legal document status report of legal documents sent to the recipient a legal document server.

Anecki, [0122]-[0123] (emphasis added).

In one embodiment of a legal document server, a legal document administrator can create an amendment to an existing legal document and send the amendment to a recipient. Referring again to FIG. 22, a legal document administrator uses the previously described search entry form and a filtered result list to select a legal document to amend.

Anecki, [0128].

The "filtering" discussed above is based on a search of a name of a recipient of a legal document. A name based search has nothing to do with classification information classifying an invention disclosure into a technology area.

With regard to claim 4, Anecki does not disclose selecting an evaluator based on the classification information. As discussed above, Anecki does not disclose classification information. As such, Anecki cannot disclose the above limitation. The Examiner, however, relies on the following passages of Anecki to find the above limitation:

FIG. 7 is a sequence diagram of an embodiment of a process for providing an approval status report according to the present invention. A legal document server begins the process of generating a legal document 1600. In this example, the generation of the legal document requires approval from two directors, director A and director B. Director A evaluates the request and approves the legal document generation by sending a director A approval 1601 to the legal document server using a director A client 1602. The legal document server updates the legal document in progress 1604 and puts the updated status of the legal document in progress into a database maintained by a legal document database server 1402.

Anecki, [0092].

Nothing in the above, however, indicates that the "directors" are selected based on classification information classifying an invention disclosure into a technology area.

With regard to claim 17, Anecki does not disclose allowing access to said disclosure after storing the plurality of disclosure information within said database and prompting said plurality of inventors for invention disclosure approval. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitation.

With regard to claim 23, Tran does not disclose prompting the user for classification information, which refers to a technology area. The Examiner relies on passages

in paragraphs [0019] and [0043] of Tran to find the above limitation. These passages, however, discuss estimating the value of IP assets. As an example, paragraph [0019] states that

The Appraise button provides an electronic valuation module to estimate the value of the IP assets. Factors evaluated include term of duration of rights; status of applications made in foreign countries and fights approved there; litigation with third parties; licensing status; technical nature of invention (three categories: basic technology, vastly improved technology and marginally improved technology); related patents; technical dominance of the IP asset, as judged by degree to which invention has been developed into a superior concept, extent and clarity of specification; clarity of range of technology if there is something unclear in the range of technology for which fights have been formed or there is concern over the occurrence of infringement-related disputes; relationship to use of IP rights possessed by third party; technical superiority to substitute technology; extent to which invention has been proven in real use; necessity of additional development for commercialization; markets for commercialization; transfer and distribution potential; inventors (or right-holders)'s intent to engage in continual research and development and the possibility of applying the results; potential restrictions on the places that it can be licensed to (such as limits on the term and region of implementation); the right-holder's ability to exercise its rights against infringing parties; the possibility that rights will be invalidated, canceled, or limited; the business potential of the invention; the possibility that substitute technology for the invention will be developed; the potential for competing or substitute products will appear; the ease that imitation products be easily manufactured; the ease of detecting infringing products; the size of the market, the market scale, the market share that is acquirable and the time frame for acquiring the targeted market share; the life span for the product's market; the price that a customer is willing to pay for the value generated by the relevant patent right; and the sustainability of the profit.

Tran, [0019].

Estimating the value of IP assets has nothing to do with prompting the user for classification information, which refers to a technology area.

With regard to claim 23, Anecki does not disclose allowing access to various users to access the information, notifying an evaluator in response to the classification information and prompting an evaluation from the evaluator. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitations.

With regard to claim 37, Tran does not disclose coupling said user information with said invention disclosure. As admitted by the Examiner, Tran does not disclose entering disclosure information to create an invention disclosure. See, Office Action, January 10, 2008, p. 20. As such, Tran cannot disclose the above limitation.

With regard to claim 37, Anecki does not disclose performing a search to determine the state of the art associated with said invention disclosure wherein said search is at least partially directed by at least one inventor of said invention disclosure. The Examiner relies on Figure 1 and passages in paragraph [0041] of Anecki to find the above limitation. These passages, however, discuss an email server:

The services of the legal document server are further extended by an email server 1080. The email server provides services to send email messages by the legal document server to the customer, marketing representatives, directors, administrators, and legal counsel. A single email server is shown for clarity and the use of a single email server is not intended as a limitation of the invention.

Anecki, [0041].

An email server has nothing to do with performing a search to determine the state of the art associated with an invention disclosure. Moreover, as explained above, Anecki does not discuss invention disclosures or inventors.

Assuming, *arguendo*, Tran and Anecki disclose the elements of claims 1, 17, 23 and 37 as argued by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner asserts that it would have been obvious to combine Tran and Anecki “for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing” Tran, however, is directed to systems and methods for trading intellectual property. Tran, Abstract. Tran states that

Systems and methods cost-effectively are disclosed to facilitate and enhance the licensing and trading of IP assets. The system supports purchasing or selling of intellectual property related products and services with a computerized bid, auction and sale system over a network such as the Internet. The techniques provide IP owners with access to an open market for trading IP. The techniques support a service-based auction network of branded, online auctions to individuals, businesses, or business units. The techniques offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and target technology.

Tran, [0006].

The apparent “open market for trading IP” provided by Tran has nothing to do with the “tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation.” Tran is directed to systems and methods to “facilitate and enhance the licensing and trading of IP assets.” Tran, [0016]. The licensing and trading of IP assets has nothing to do with “document preparation.” One of ordinary skill, therefore, would not have had reason to combine Anecki with Tran.

Assuming, *arguendo*, Tran, Anecki and Tran707 disclose each and every element of claims 1, 17, 23 and 37, the Examiner has not cited reasons sufficient to establish a *prima facie* case of obviousness. See, MPEP 2142 (“[R]jections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) The

Examiner asserts that it would have been obvious to combine Tran, Anecki and Tran 707 "for the purpose of procuring intellectual property assets, thereby enabling user to locate and navigate the information needed to procure IP assets" This vague, conclusory reasoning, however, appears to lack technical merit. Tran707 is directed to patent-it-yourself type software: "Software that can be downloaded from the server 100 includes a module to assist a user in generating a patent application," Tran707, [0041]; "Since the member is generating the bulk of the work product, the cost in procuring the IP asset is reduce, while responsiveness is enhanced," Tran707, [0089]. Why would one of ordinary skill find reason to combine Tran and Anecki with Tran707 when Tran707 already appears to assist in "procuring intellectual property assets" and "enable user to locate and navigate information needed to procure IP assets," see, Tran707, [0041]-[0080]?

Claims 2-16, 18-22, 24-36 and 38-41 are patentable because they depend from one of the independent claims.

Applicants' Attorney submits that the claims are in a condition for allowance. Applicants' Attorney respectfully requests a notice to that effect. Applicants' Attorney also invites a telephone conference if the Examiner believes that it will advance the prosecution of this application.

Please charge any additional fees or credit any overpayments as a result of the filing of this paper to Deposit Account No. 06-1510.

Respectfully submitted,

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